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EXAMINER

ENATSKY, AARON L

ART UNIT PAPER NUMBER

3713

DATE MAILED: 12/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/630,604

Applicant(s)

GARAHI ET AL.

Examiner

Aaron L Enatsky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-86,89-133 and 135-144 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-86,89-133 and 135-144 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Examiner acknowledges receipt of Applicant's amendment on 9/19/03. Claims 1-86, 89-133, and 135-144 remain pending.

Drawings

New corrected drawings are required in this application because of problems that detailed in a draftsman's review. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-86, 91-133 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,004,211 to Brenner et al in view of Lappington et al. '413 (Lapp). In regard to claims 1 and 44, Brenner et al. teaches of an interactive off-track wagering (2:35-36) that is run over a computer based system to racing fans in their homes (5:61-64). Wagering is accomplished through network communication from a user terminal to a totalisator (7:35-43), and is communicated wirelessly from the user to the user terminal through any suitable user interface (7:21-34). While Brenner et al. does not specifically teach that the wireless remote control device

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has a screen with on-screen options, but he does teach that any suitable wireless user interface device can be used in conjunction with television sets for display (7:21-34). Lapp teaches of an interactive TV set-top system using a wireless remote handheld that is capable of displaying events for the purpose of switching between multiple interactive concurrent programs (Abstract). It is well known in that art that audio/video remote controllers are wireless multifunctional devices with user interface screens producing user selectable menus. Examples of such are devices specifically made as all-in-one audio/video remotes, or personal digital assistants programmed with an extra function of control audio/video systems. With the remotes such as a personal digital assistant (PDA) it also would have been obvious to one skilled in the art at the time to display informational/wager choices on the PDA to allow the race to be displayed on a separate display continuously. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brenner et al. to use the wireless handheld taught by Lapp for the purposes as taught above in addition to reasons taught by Lapp such as view multiple concurrent events without losing scores. This would also allow one to place multiple concurrent bets on different races, releasing the constraints of betting only on a single game at any one time.

In regards to claims 2-6 and 45-49, Brenner et al. teaches that the race is a horse race (6:3) where a user can select a horse for a wager, a racetrack, a race, a wager type, and a wager amount (2:45-51).

In regards to claims 7-8 and 50-51, Brenner et al. teaches that totalisator is a computer system capable of handling user transactions, user accounts, crediting accounts when the wager is successful, and standard computer network communications (7:35-54).

In regards to claims 9 and 52, Brenner et al. teaches that the in-home equipment includes conventional television sets (7:26).

In regards to claims 10 and 53, Brenner et al. teaches the transmission of racing data via cable, satellite, or other mediums (6:55-61) and wagers transmitted over a network to computer equipment (7:35-54) where both types of information are received and sent to a user terminal. Brenner et al. does not teach that the user terminal is a set-top box, however it is obvious to one skilled in the art that end user terminals for processing cable or satellite data for display on a television set can be set-top boxes.

In regards to claims 11-12 and 54-55, Brenner et al. teaches that the user terminal comprises personal computer equipment (7:55-67), and the computer equipment transmits the wager information to other computer equipment for processing (7:35-54).

In regards to claims 13-30 and 56-73, Brenner et al. teaches handicapping information and race results received by a user terminal (10:9-23). It was established earlier that wireless remote taught by Brenner et al. could comprise of a number of known remote control elements well known in the art such as a PDA therefore it would have been obvious to display handicap information and race results on the wireless remote device sent from the user terminal. In regard to the various claimed wireless remote devices, the handheld computer, electronic book, and web tablet it is well known in that art that these devices are function equivalents and it would have been obvious to one skilled in the art to substitute these devices for one another. It was also established earlier that the user terminal is a computer device (7:21-34) situated in a user's home (5:59-67) that is capable of network communications (7:35-54). It is well known in the art that a computer can function both as a set-top box as well as functions of personal computer making

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the devices functional equivalents. It would have been obvious to one skilled in the art at the time the invention was made to use various equivalent wireless remote devices in communication with a computer device as a user terminal for the purpose of receiving and displaying handicap and race results information to a user where the personal computer communication combinations would be better suited to a more technical/computer savvy demographic while the set-top box combinations to a less technical demographic.

In regards to claims 31-43 and 74-86, Brenner et al. teaches that each user can place a wager (7:35-41) from in home equipment (5:35-64) where the wagering system comprises of a large array of user terminals (7:10-11). This would suggest that users are placing wagers that are independent of one another and establishing individuality to the wagering system through the use of a personal identification code (8:41-50). Brenner et al. does not teach the use of a plurality of wireless devices communicating with the user terminal. However, it has long been considered to be within ordinary skill in the art to duplicate elements and their corresponding functions, especially in network communication where multiplicity of like devices is the norm, therefore, obvious to one skilled in the art at the time the invention was made to have a plurality of handheld devices place independent wagers with a user terminal. In regards to the choice of communication equipment, as established above, it would have been obvious to one skilled in the art to interchange functional equivalents of the handheld devices and the set-top or personal computer in their respective communication hierarchy.

In re claims 91-133, Brenner et al. in view of Lapp teach the claimed limitations as discussed above. In addition, as is well known in the art, communication exists with computer systems interpreting machine-readable instructions.

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In re claims 142-144, Brenner et al. in view of Lapp teaches the claims limitations as discussed above, but does not disclose a set-top box as the sole communication interface between a handheld device and wagering servers. However, as is well known in the art, set-top devices can function both to transmit and receive information to/from remote servers. Lappington also teaches that a user can contact operations by using a wireless or wired medium (9:25-27) similar to how data is initially received. In view of Lappington's teaching of commensurate transmit and receive communication mediums, it would not be beyond one of ordinary skill to modify Brenner in view of Lappington so that a single integrated device serves both purposes to reduce system complexity and costs.

Claims 89-90, and 134-141 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,004,211 to Brenner et al. in view of U.S. Patent No. 5,999,808 to LaDue. Brenner et al. teaches the above mentioned horse race wagering system, but does not disclose the use of a wireless application protocol for communication with a computer system. LaDue teaches the use of a wireless application protocol for use in wireless gaming and wagering (Abstract) for the purpose of operating seamlessly with existing wireless networks without need for further modification (2:26-29). LaDue also teaches the use of a handheld computer for communication with the wagering/gaming system with a built in screen capable of displaying users selectable menus (Fig 9). It would have been obvious to one skilled in the art at the time the invention was made to combine the wireless application protocol system for wagering by LaDue with the horse race wagering system as taught by Brenner et al. for the purpose of seamless operation with the existing wireless network infrastructure and so that wagering can take place anywhere legal including the race track or in a user's home.

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In re claims 134-136, 138, and 140, Brenner et al. in view of LaDue teach a computer network system for wagering as discussed above. In addition, as is well known in the art, communication exists with computer systems interpreting machine-readable instructions.

In re claims 137, 139, and 141, Brenner et al. in view of LaDue teach a computer network system for wagering as discussed above. While not specifically disclosing computer equipment as part of a local area network, Brenner et al. shows in Fig. 1 shows the wager processing equipment interconnected. Whether the equipment is connected in a local area or a wide area network, lacking criticality, would not serve to distinguish over prior art. The method of interconnection between equipment would not affect system functionality and could be made equivalent assuming adequate bandwidth.

Response to Arguments

Applicant's arguments have been fully considered, but are not considered persuasive.

Issue A: Applicant argues that Brenner in view of Lappington do not teach all elements required by claims 1, 44, and 91. This argument is of the same scope provided in Applicant's arguments of paper no. 13. Examiner still contends that Lappington, though not specifically teaching an integrated device, still meets Applicant's claim of wirelessly transmitting to *in-home user equipment*. The dialer is but one embodiment used to transmit the user information to the remote computer equipment. Furthermore, Lappington teaches that other communications mediums may be employed to remotely transmit information such as radio or cable (9:19-27). As is well known, set-top devices can function both to transmit and receive information to/from remote servers and in view of Lappington's teaching of commensurate transmit and receive communication mediums, it would not be beyond one of ordinary skill to modify Brenner in

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view of Lappington so that a single integrated device serves both purposes. Additionally, Lappington clearly shows that game information can be displayed on the disclosed handheld (Fig. 15 refs. 510-512).

Issue B: Applicant's arguments are directed toward the contention that one would have no reason to combine Brenner in view of Lappington because Examiner's motivations are insufficient to support these modifications. The specific feature in question is that of game information displayed to a player on a remote wireless device. Examiner explained above that while Brenner lacks this feature, Lappington teaches that it was well known at the time of the invention to have a wireless communicating handheld device that can display game information in addition to information that is shown in a separate display. Examiner believes absent a showing of criticality or unexpected results, Applicant's system functionality has merely separated gaming and wagering features known by Brenner into a set-top device and wireless device with a screen. Shifting the location of parts of a system, while possibly creating a novel feature, does not meet the burden of nonobviousness. The ultimate operability of Applicant's system, which is a system of providing remote wagering such as disclosed by Brenner, is not thereby modified by using a wireless remote with a game display. Thus, Examiner's use of Lappington to provide these missing features is sufficient to show that Applicant's invention is an obvious modification of Brenner to incorporate existing technology set-top games.

Issue C: In regard to the rejection over Brenner in view of LaDue, Applicant argues that Brenner in view of LaDue does not teach user wireless equipment communicating racetrack equipment. Brenner was discussed as teaching wireless wagering to and from a user terminal through any suitable user interface. Brenner also teaches information delivery can be accomplished through

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broadcast or satellite systems (7:4-9) and that transactions can be accomplished through any suitable, conventional, communication circuitry (8:30-40). LaDue was used to show that using a wireless application protocol for wireless wagering is known and can be integrated into existing wireless networks without requiring additional network build-outs. LaDue also clearly shows that user equipment communicates wirelessly to place wagers (Fig. 9 and 9B). With this information Examiner believes that there are no gaps in features taught by Brenner in view of LaDue to meet Applicant's claims and the rejection was proper.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron L Enatsky whose telephone number is 703-305-3525. The examiner can normally be reached on 8-6 M-Th.